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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/725,487 | 12/03/2003 | Christopher P. Paul | 10.279.002 | 3986 |

7590 05/12/2004

Bradford Kile
655 15th Street NW
Washington, DC 20005

EXAMINER

FERNSTROM, KURT

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3712

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/725,487 | Applicant(s) PAUL, CHRISTOPHER P. | |
| | Examiner Kurt Fernstrom | Art Unit 3712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 12, 14 and 15 is/are objected to.
- 8) ☒ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motkya. Motkya discloses in Figure 3 and in the specification a device for attaching a writing utensil to a ring binder comprising an attachment member 10 which is attached to a writing utensil 24 via curved portion 16, and has holes 18 for releasable attachment to a multi-ring notebook binder. Motkya discloses a single attachment member rather than first and second attachment members. However, the device as claimed is an obvious variation on the device disclosed by Motkay, as it operates in substantially the same manner. Providing two separate attachment members, rather than one large attachment member, does not have any functional purpose which is not realized by the device of Motkya. The same is also true of the recited shape in claim 2. With respect to claims 4 and 7, the device of Motkya is attached to both the body and a top portion of the writing utensil. Using the device with a writing utensil having a cap would have been obvious, as caps are a well known feature of writing utensils, and would read on the language of claims 4 and 7. With respect to claims 5 and 6, the portion 16 of the device of Motkya is essentially a ring.

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The methods of 10, 11 and 13 and 16 are inherent in the device suggested by Motkya, as described above, in view of well known features of ring binders..

Allowable Subject Matter

Claims 8, 9, 12, 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose or suggest all of the limitations of the allowable claims. With respect to claims 8 and 14, there is no suggestion in Motkya or the other prior art of a C-shaped member having a telescoping member as claimed. With respect to claim 9, there is no suggestion in Motkya or the other prior art of a C-shaped member as claimed which engages a ring of the ring binder. With respect to claim 12, there is no suggestion in Motkya or the other prior art of a securment attachment which is integrally formed with the writing utensil. Motkya teaches away from this feature, as is discloses a device into which the writing utensil is almost completely inserted. If the attachment device shown in Figure 3 were integral with the writing utensil, the utensil would be inoperable. With respect to claim 15, there is no suggestion in Motkya or the other prior art of an attachment means which engages a spiral notebook. The device of Motkay would not be usable with a spiral notebook, as the holes 18 require rings than can be opened and closed.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kovacik, Aronson, Bedol, Vernon, Caputi, Davies, Bilbrey, and Schade disclose various devices for holding writing utensils in notebooks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kurt Fernstrom

KF
May 11, 2004